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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,812	02/09/2000	Bert D. Cook JR.	5564 413436/080	5712

7590 06/19/2002  
Daniel J Meaney Jr Esq  
P O Box 22307  
Santa Barbara, CA 93121

EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/502,812

Applicant(s)

COOK ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 and 66-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 15, 16, 23-40, 66-68 and 73 is/are allowed.
- 6) ☒ Claim(s) 6-14, 17-22, 69-72 and 74-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt is acknowledged of the Information Disclosure Statements (2) received on 10 May 2002. Claims 1-40 and 66-76 are pending in this application.

#### ***Specification***

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

#### ***Claim Objections***

3. Claims 1 are objected to because of the following informalities:

Re claim 1, line 7: Replace "portion said" with -- portion of said --.

Re claim 6, line 11: Replace "portion said" with -- portion of said --.

Re claim 15, line 8: Replace "portion said" with -- portion of said --.

Re claim 23, line 2 (page 6): Replace "portion said" with -- portion of said --.

Re claim 66, line 7: Replace "portion said" with -- portion of said --.

Re claim 73, line 7: Replace "portion said" with -- portion of said --.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-14, 17-22, 69-72, and 74-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "Said data storage device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Re claims 11, 17, 69, and 74: The use of "relatively hard..." and "a thickness between a maximum thickness..." renders the claim vague/indefinite since it is unclear what the required degree of hardness/bendability/abradability is, and since the maximum and minimum thickness levels are not specified, but are left to interpretation.

***Allowable Subject Matter***

5. Claims 1-5, 15, 16, 23-40, 66-68, and 73 are allowed.

6. The following is an examiner's statement of reasons for allowance: The prior art of record fails to specifically teach:

i) A portable card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information and for embedment of the storage member within the substrate;

ii) A portable card adapted to be used in a card processing system having a data processing station comprising a substrate having a predetermined shape; and a removable and reinsertable accessible embedded storage member having at least one layer of storage material

for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to remove and expose at least a portion of the storage member to facilitate processing of stored information by a data processing station and for embedment of the storage member within the substrate;

iii) A portable card adapted to be used in a card processing system having a data processing station comprising a substrate having a substantially planar and generally rectangular shape; and at least one removable and reinsertable accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to remove and exposed at least a portion of the storage member to facilitate processing of stored information by a data processing station and for embedment of the storage member within the substrate;

iv) A data storage device comprising a substrate; and an accessible embedded storage member having a predetermined shape, the storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information.

v) A magnetically encoded card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one magnetic recording material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member

to facilitate processing of stored information by a transducer and for embedment of the storage member within the substrate.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Rovin (US 5,049,728), Klatt (US 5,877,488), Hasegawa et al. (US 4,780,604), Nishikawa et al. (US 6,398,114), Gannyo et al. (US 5,408,384), Nelson et al. (US 4,503,125), Riehle (US 6,254,713), Kodai et al. (US 4,695,925), Hills (US 5,036,430), and Kanda (JP410144391A).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel Walsh** whose telephone number is **(703) 305-1001**. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DW  
6/14/02



THIEN M. LE  
PRIMARY EXAMINER